



2685

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Brian E. Merrigan

Serial No.: 10/051,445

Title: FILTER FOR BROADCAST RECEIVER TUNING

Filed: January 18, 2002

Attorney Docket No.: 1496.00195

Examiner: Nguyen, T.

Art Unit: 2685

In Response To: Office Action mailed July 13, 2004

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Technology Center 2600

I hereby certify that this letter, the response or amendment attached hereto are being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 26, 2004.

By:

Jan M. Dunbar
Jan M. Dunbar

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT
UNDER 35 U.S.C. §121

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

R E M A R K S

Applicant's representative provisionally elects with traverse claims 1-11 and 18-23, Group I. Applicant's representative respectfully requests that the Examiner reconsider and withdraw the restriction requirement.

Group I, claims 1-11 and 18-23 and Group II, claims 12-17, are not separate groups. An application may be properly

required to be restricted on one or more patentably distinct inventions only if (a) the inventions are either independent or distinct as claimed **and** (b) there is a **serious** burden on the Examiner (see MPEP §803, emphasis added by Applicant's representative).

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent and distinct inventions (MPEP §803, under the heading Restriction-When Proper). The Examiner does not appear to have met the burden of showing a *prima facie* case why there would be a serious burden to search and examine the entire application (MPEP §803).

Furthermore, Examiners must provide reasons and/or examples to support conclusions (see MPEP §803, under the heading GUIDELINES). The Examiner has not presented objective evidence or appropriate explanation for the conclusory statement that Group I has separate utility from Group II (see Office Action on page 2, paragraph 2). Therefore, the Office Action does not appear to establish a *prima facie* showing that there would be a **serious** burden on the Examiner to search and examine the entire application (MPEP §803). As such, the requirement for restriction does not appear to be proper and should be withdrawn (MPEP §803).

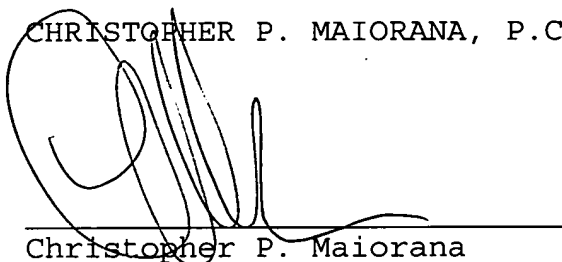
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 12-2252.

Respectfully submitted,

CHRISTOPHER P. MAIORANA, P.C.

A handwritten signature in black ink, appearing to read 'C. Maiorana', is written over a horizontal line.

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Dated: July 26, 2004

Docket No.:1496.00195